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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/547,284 | 04/11/2000 | Hiroshi Satomi | 862.C1892 | 4978 |

5514 7590 06/15/2004

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NEW YORK, NY 10112

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| EXAMINER |
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COLBERT, ELLA

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| ART UNIT | PAPER NUMBER |
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3624

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/547,284

Applicant(s)

SATOMI ET AL.

Examiner

Ella Colbert

Art Unit

3624

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9-25,29-33,37-47,49-56,60,86-88,91,95 and 104-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11, 12, & 14-17.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-5,9-25,29-33,37-47,49-56,60,86-88,,91,95 and 104-108.

DETAILED ACTION

1. Claims 1-5, 9-25, 29-33, 37-47, 49-55, 59, 60, 86-88, 91, 95, and 104-108 are pending (the best that the Examiner can figure out according to all of the amendments submitted) in this communication filed 06/04/02 entered as Pre-Amendment C, paper no. 13.
2. The IDS filed 05/10/00 has been entered as paper no. 4.
3. The Priority paper filed 07/10/00 has been entered as paper no. 5.
4. The Pre-Amendment A filed 07/18/00 has been entered as paper no. 6.
5. The Drawing changes filed 07/18/00 have been entered as paper no. 7. The drawing changes have been approved.
6. The Pre-Amendment B filed 10/11/01 has been entered as paper no. 10.
7. The IDS filed 10/11/01 has been entered as paper no. 11, the IDS filed 05/16/02 has been entered as paper no. 12, the IDS file 08/28/02 has been entered as paper no. 14, the IDS filed 12/12/02 has been entered as paper no. 15, the Supplemental IDS filed 01/15/03 has been entered as paper no. 16, and the IDS filed 04/10/03 has been entered as paper no. 17.
8. The Pre-Amendment C filed 06/04/02 has been entered as paper no. 13.

Election/Restrictions

9. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, 9-25, 37-40, 49-55, 59, 91, 95, and 104-108, drawn to searching a first database, classified in class 707, subclass 3.

- II. Claims 29-33, 41-47, 60, 61, 72-84, 86-88, drawn to a system for providing information to a user, classified in class 709, subclass 223.

10. Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case Group I in the instant application can be used for providing information to a user using an extraction step for searching a database.

Group II in the instant application can be used attaching a second information extracted from a second database and printed in a margin, outputting the first information with the second information, an image input unit for inputting an original image, and transmitting the original image to a server.

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

12. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Inquiries

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


E. Colbert

June 14, 2004